

DOCKET NO.: 231062US0/ds

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1617

Guillaume CASSIN

SERIAL NO: 10/698,403

EXAMINER: Cruz, Kathrien Ann

FILED: November 3, 2003

FOR: SILICA/ALUMINA COMPOSITE FILLER USEFUL FOR MATTIFYING
SKIN

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



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IN RE APPLICATION OF :
Guillaume CASSIN : EXAMINER: CRUZ, KATHRIEN ANN
SERIAL NO: 10/698,403 :
FILED: NOVEMBER 3, 2003 : GROUP ART UNIT: 1617
FOR: SILICA/ALUMINA COMPOSITE :
FILLER USEFUL FOR
MATTIFYING SKIN

ATTACHMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

Initially, Applicant would like to thank Examiners Hui and Cruz for the courteous telephonic interview conducted September 2, 2009. During the Interview, the pending obviousness rejection was discussed. The substance of the Interview is reflected in Applicant's comments below.

The Examiner rejected claims 1-20 under 35 U.S.C. § 103 as obvious over U.S. patent 5,587,170 ("Caisey") in view of U.S. patent 4,954,532 ("Elliott") and further in view of U.S. patent 2,892,797 ("Alexander"). This rejection is based upon the Examiner's erroneous interpretation of the applied art, and the Examiner's erroneous application of the applied art to the claimed invention. Contrary to the Examiner's assertions, the applied art neither teaches nor suggests the claimed invention – the applied art would not lead one of ordinary skill in the art to attempt to use the required dispersion of colloidal particles of at least one silica/alumina composite filler in the invention methods of treating greasy skin.

Caisey discloses colloidal suspensions which form a film. (See, col. 1, lines 18-21). The resulting film functions by modifying the reflective properties of the skin. (See, col. 1, lines 21-23). As recognized by the Examiner, Caisey “does not disclose a process of treating greasy skin” or “the inorganic filler as being a silica/alumina composite filler.” (Office Action at page 5).

Elliott teaches using silanized silica to treat greasy skin. (See, col. 1, lines 4-5, 48-65). The silanized silica is effective on greasy skin because it is a sebum/lipid absorbent. (Id.). Because Elliott teaches that silanized silica must be used to treat greasy skin, Elliott cannot suggest the use of non-silanized silica to treat greasy skin. Stated another way, Elliott contains absolutely no indication whatsoever that non-silanized particles could be sebum/lipid absorbents or could be used to treat greasy skin. Accordingly, the combination of Caisey and Elliott would lead to treating greasy skin using silanized silica (but not non-silanized silica) because Elliott teaches treating greasy skin in this manner and Caisey is silent concerning treating greasy skin.

Alexander discloses non-silanized particles. Moreover, Alexander neither teaches nor suggests that such particles could be used to treat greasy skin.

Given these teachings, the applied art cannot be properly combined to yield the invention methods. To the contrary, the applied art teaches that greasy skin can be treated by using silanized silica as a sebum/lipid absorbent. The applied art neither teaches nor suggests using the required dispersion of particles to treat greasy skin.

The Examiner asserted that motivation to combine the applied art to yield the

invention methods would have come from: (1) Caisey and Elliott both teach the treatment of greasy skin on an individual who has greasy skin; (2) it would have been obvious that any suitable silica sol (such as Alexander's) could be used in the combined teachings of Caisey and Elliott; and (3) one of ordinary skill in the art would have been motivated to use Alexander's alumina/silica sol in the combined teachings of Caisey and Elliott due to its increased stability. (Office Action at page 6). However, these assertions of motivation are inadequate to support a *prima facie* case of obviousness.

Regarding (1), the Examiner recognized that Caisey "does not disclose a process of treating greasy skin." Accordingly, this asserted motivation fails.

Regarding (2) and (3), Caisey's particles form a film, whereas Elliott's particles are absorbents. It would not have been obvious to combine these two references given the different required functionalities of the respective particles. That is, it would not have been obvious to use a film forming agent which reflects light in place of an absorbent which absorbs sebum/lipids, or *vice versa*. Thus, it would not have been obvious to combine these references, or to use "any suitable silica sol" in such a hypothetical combination of references in which specific functionalities are required. Similarly, it would not have been obvious to use Alexander's "stabilizing" particles when other functionalities (film forming, absorbency) are required.

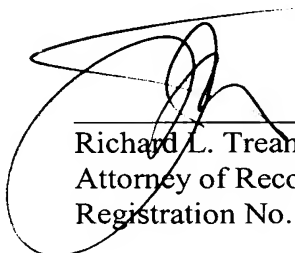
As explained above, no reason exists to combine the applied art in the required manner to yield the invention methods. Rather, the pending rejection is based on impermissible hindsight, using the present application as a guide to provide the missing motivation, and should be withdrawn.

Application No. 10/698,403
Attachment in Support of Pre-Appeal
Brief Request for Review

For all of the above reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C § 103.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "Richard L. Treahor", is written over a horizontal line.

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